

Application Number: 10/654,167
Reply to O.A. of April 13, 2005

Dkt. No.: DT-024-IJS-01

REMARKS

In the outstanding Office Action, claims 10 and 18-20 stand withdrawn, and claims 1-9 and 11-17 were rejected under 35 U.S.C. § 102(b).

In the present Amendment and Response, claims 3, 7, 13, and 16 have been cancelled and claims 1, 4, 8, 11, 14, and 17 have been amended. Claims 1-2, 4-6, 8-9, 11-12, 14-15, and 17 are currently pending in the instant Application.

§ 102 Rejections

Claims 1-9 and 11-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,197,380 ("Chao"). Further, claims 1-9 and 11-17 were also rejected under 35 U.S.C. § 102(b) as being anticipated by JP-56041279 ("Susumu"). An English translation of the Susumu reference is attached herewith.

Claims 1 and 11 Are Not Anticipated by Chao

Claims 1 and 11, as amended, are directed to compositions having at least the following elements: ethylene methyl methacrylate copolymer, a wax, and a tackifying resin.

Chao discloses a hot melt adhesive having a fluoroelastomer, an ethylene copolymer, and a tackifier. Chao does not disclose a wax. Thus, all claimed elements are not present in Chao. Reconsideration and withdrawal of these rejections are respectfully requested.

Claims Depending from Claims 1 and 11 Are Patentable

Because claims 2, 4-6, 8-9, 12, 14-15, and 17 depend directly or indirectly from claim 1 or claim 11 and incorporate all the limitations of either claim 1 or claim 11, the above arguments obviate the basis for these grounds of rejection. Thus, claims 2, 4-6, 8-9, 12, 14-15, and 17 are not anticipated by Chao. Reconsideration and withdrawal of the rejections is respectfully requested.

Claims 1 and 11 Are Not Anticipated by Susumu

As discussed above, claims 1 and 11 are directed to a composition having at least the following elements: ethylene methyl methacrylate copolymer, a wax, and a tackifying resin.

Susumu discloses a composition that includes a very broad genus encompassing all ethylene-methacrylate ester copolymers. When a prior art reference does not name the claimed compound, anticipation can only be found if the classes of substituents in the prior art reference "are sufficiently limited or well delineated." See M.P.E.P. § 2131.02 (citing *Ex Parte A*, 17 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 1990)). In fact, the reference is not anticipatory unless

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one of skill in the art, reading the prior art reference, is able to "at once envisage" the claimed compound in the generic formula. *See In re Petering*, 301 F.2d 676, 681 (C.C.P.A. 1962); M.P.E.P. § 2131.02. The disclosure in Susumu of the broad genus of all ethylene-methacrylate ester copolymers is not sufficiently limited or well delineated to encompass an ethylene methyl methacrylate copolymer. Thus, claims 1 and 11 are not anticipated by Susumu.

Further, Susumu's teaching of all ethylene-methacrylate ester copolymers simply embraces such a large number of species that it cannot possibly anticipate the present invention. In a case in which the claim at issue was directed to a "alkali metal hypochlorite," the Court of Customs and Patent Appeals held that a reference disclosing "alkaline chlorine or bromine solution" was too broad to be anticipatory. *See In re Meyer*, 599 F.2d 1026, 1031-32 (C.C.P.A. 1979). Similarly, the disclosure in Susumu of a composition including an ethylene-methacrylate ester copolymers is too broad to anticipate the ethylene methyl methacrylate copolymer of claim 1. Thus, Susumu fails to teach or suggest the invention of claims 1 and 11. Reconsideration and withdrawal of the rejections is respectfully requested.

Claims Depending from Claims 1 and 11 Are Patentable

Because claims 2, 4-6, 8-9, 12, 14-15, and 17 depend directly or indirectly from claim 1 or claim 11 and incorporate all the limitations of either claim 1 or claim 11, the above arguments obviate the basis for these grounds of rejection. Thus, claims 2, 4-6, 8-9, 12, 14-15, and 17 are not anticipated by Susumu. Reconsideration and withdrawal of the rejections is respectfully requested.

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CONCLUSION

Applicant respectfully submits that claims 1-2, 4-6, 8-9, 11-12, 14-15, and 17 are in condition for allowance. Reconsideration and a Notice of Allowance for all pending claims is respectfully requested.

This Amendment and Response is being submitted on or before October 13, 2005, with a Petition for a Three Month Extension of Time, and the required fees, making this a timely response. It is believed that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment, to Deposit Account No. 06-2241.

Respectfully submitted,

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